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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/627,197	07/27/2000	Jeffry Jovan Philyaw	PHLY-25,372	1263
25883	7590	10/06/2004	EXAMINER	
HOWISON & ARNOTT, L.L.P			MAURO JR, THOMAS J	
P.O. BOX 741715				
DALLAS, TX 75374-1715			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/627,197

Applicant(s)

PHILYAW, JEFFRY JOVAN

Examiner

Thomas J. Mauro Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the RCE filed on July 15, 2004. Claims 1-15 remain pending. A formal action on the merits of claims 1-15 follows.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 recites, "all of the functionality to both scan and effect a connection is contained within said housing." This housing as referred to in the claim is the battery pack. Given the information in the drawings, specifically figure 40, and the information contained within the specification, Examiner does understand how the battery pack [housing], i.e. scanning module, can solely effect a connection when nowhere in the drawings or the specification is it disclosed that the housing contains an antenna or a dialing circuit, etc. In addition, if, for the sake of argument, the housing can effect a connection, then Examiner sees no need for the data interface (3810) and furthermore, the attachment to a cellular phone if the housing can accomplish the task without the use of the phone. Therefore, applicant's disclosure is insufficient to allow one of ordinary skill in the art to

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make or use the invention without undue experimentation because applicant did not adequately disclose the necessary apparatus to perform the regarding claimed apparatus. See *In re Gunn*, 190 USPQ 402, 406 (CCPA 1976).

3. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 is directed towards "A battery pack." As Examiner has stated previously and above, no support is shown to indicate that "all of the functionality to both scan and effect a connection is contained within said housing." If applicant overcomes this rejection to indicate that the phone causes the connection to be made to the network, a further problem exists as claim 1 is claiming a battery pack, not a phone which would allow such a connection to be made. Proper clarification and amendments are required to overcome this rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al. (U.S. 5,923,735) in view of Wilz, Sr. et al. (U.S. 6,076,733) and Rosen et al. (U.S. 6,014,090).

Regarding claim 1, Swartz et al. teaches the invention substantially as claimed, a battery pack for a wireless communication device comprising:

- a. A housing adapted to be removably attachable to a wireless communication device that can wireless connect to a global communication network (GCN) to provide a communication link therewith, the housing including an external shell defining an optical port therethrough and having an operational power interface and a data interface disposed on an exterior surface thereof [Swartz -- **Figure 10, Col. 9 lines 59-65, Col. 11 lines 63-67 and Col. 12 lines 1-7 and Col. 13 lines 1-6 – Housing, i.e. battery pack contains an optical reader, i.e. bar code scanning module, that has a power interface, i.e. batter, and data interface, i.e. to enable sending of decoded bar code information to cellular phone to transmit wirelessly. In addition, cellular phones are required to connect and access a global communications network (GCN) in order to place calls, as is taught in Col. 13 lines 1-6;**
- b. At least one battery disposed within the housing and electrically connected to the operational power interface [Swartz -- **Figure 10 – item 204 and Col. 12 lines 2-3 – Battery is disposed inside the battery pack housing to power device;** and
- c. An optical reader disposed within the housing for scanning an optical indicia through the optical port and producing signals indicative of information encoded in the optical indicia, the optical reader being operably connected to the data interface and

powered by the battery [Swartz -- **Figure 10 – items 202 and 204, Col. 11 lines 65-67 and Col. 12 lines 1-7 – Optical reader, i.e. bar code scanning module, is disposed within the battery pack housing for scanning and decoding bar codes. This module (202), as can be seen in figure 10, is connected to the battery (204) to receive power to operate**];

d. Whereby a wireless communication device attached to the battery pack can obtain operational power from the operational power interface and can access signals indicative of the information encoded in the optical indicia from the data interface [Swartz -- **Figure 10 – item 202, Col. 11 lines 65-67 and Col. 12 lines 1-7 – Cellular phone, i.e. wireless communication device, receives power through contacts, i.e. electrical interface (206) and through which communication, i.e. data transfer, between scanning module and phone occurs**].

Swartz does not explicitly teach that the optical reader, in response to scanning, causes a connection to be made on the GCN through the wireless communication device and furthermore, where the wireless communication device is web enabled.

Wilz, however, teaches an Internet Access system effected by reading a bar code symbol, either encoded with a Domain Name and Path Name (DN/PN-encoded) or Uniform Resource Location (URL-encoded), which automatically causes a connection to be established to an Internet server containing information specified in the bar code symbol [Wilz -- **Figures 1B1, 1B2, 1B3, 1B4 and Col. 2 lines 51-60**].

In addition, Rosen discloses an web enabled communication device, i.e. cell phone, for delivering local information to travelers which consists of a cellular telephone along with

a geographic location device, for example a bar code reader, which can be used to scan a bar code on a road sign to then access a resource or location, i.e. WEB page, from a resource server to provide information, such as nearby services, i.e. hotels, restaurants, gas stations, etc., which can be of help to the traveler [**Rosen -- Col. 1 lines 47-52, Col. 3 lines 13-20 and lines 40-47 and Col. 3 lines 64-67 – Col. 4 lines 1-17**].

Both Swartz, Wilz and Rosen disclose methods for providing wireless connectivity to send and receive data to a remote server using an optical reader and bar code encoded information. In addition, it is notoriously well known in the art that any kind of information or commands can be encoded into a bar code so that when decoded by an optical reader, cause certain actions to occur. It is also notoriously well known in the art that wireless devices, i.e. phones, PDA's etc. are able to wireless connect to the Web or Internet.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the encoding of remote connection establishing information in a bar code, as taught by Wilz, along with the web enabled communication device with scan capabilities, as taught by Rosen into the invention of Swartz, in order to provide a less time consuming, automated and improved method for navigating to web sites or remote locations in addition to allowing the user to obtain the most up to date information about a product, facility, service, etc., by connecting directly to an Internet server which would provide the most recently updated information, as product, service or facility information frequently changes.

Regarding claim 2, Swartz-Wilz-Rosen teach the invention substantially as claimed, as aforementioned in claim 1 above, including wherein the optical reader further comprises:

- a. A radiant energy source for generating a radiant energy for illuminating the optical indicia [Swartz -- Col. 6 lines 41-42 and Col. 12 lines 1-2 – **Scanning laser beam is generated from energy source**];
- b. A photo detector for generating output electrical signals indicative of the radiant energy incident thereon [Swartz -- Col. 6 lines 42-43 and lines 51-54 – **Bar code reading charge-coupled device (CCD) is a photo detector**];
- c. An optical system for directing the radiant energy from the radiant energy source through the optical port to the optical indicia, collecting the radiant energy reflected from the optical indicia to the optical port, and directing the collected radiant energy to the photo detector [Swartz -- Col. 6 lines 15-18 – **The optical system is one employed by general bar code scanners and scanning terminals as are well known in the art, as mentioned by the author in Col 5 lines 24-26**]; and
- d. A decoder for decoding the output electrical signals of the photo detector and producing the signals indicative of the information encoded in the indicia [Swartz -- Col. 6 lines 46-60].

Regarding claim 3, Swartz-Wilz-Rosen teach the invention substantially as claimed, as aforementioned in claim 2 above, including wherein the radiant energy source produces light having a wavelength within the visible spectrum [Swartz -- Col. 6 lines 15-17].

Regarding claim 4, Swartz-Wilz-Rosen teach the invention substantially as claimed, as aforementioned in claim 2 above, including wherein the radiant energy source produces light having a wavelength within the infrared (IR) spectrum **[Swartz -- Col. 6 lines 15-17]**.

Regarding claim 5, Swartz-Wilz-Rosen teach the invention substantially as claimed, as aforementioned in claim 2 above, including wherein the radiant energy source produces light having a wavelength shorter than visible light and longer than X-Rays **[Swartz -- Col. 6 lines 15-17]**.

5. Claims 6-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al. (U.S. 5,923,735), Wilz, Sr. et al. (U.S. 6,076,733) and Rosen et al. (U.S. 6,014,090), as applied to claim 1 above, in view of Friel et al. (U.S. 6,025,695).

Regarding claim 6, Swartz-Wilz-Rosen teach the invention substantially as claimed, as aforementioned in claim 1 above, including a battery pack comprising battery-conditioning circuitry disposed within the housing and having a first electrical connection to the battery, the battery conditioning circuitry monitoring operational battery characteristics through the first electrical connection **[Swartz -- Col. 6 lines 27-31 – Battery/Power supply system contains battery, regulator, charger and voltage detection circuit]**.

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Swartz-Wilz-Rosen, however, do not teach a second electrical connection to the data interface producing signals indicative of the charge condition of the battery on the second electrical connection, whereby a wireless communication device connected to the battery pack can access signals indicative of the operational battery characteristics on the data interface.

Friel et al. teaches a smart battery, including a memory, that may transmit data to the host device over a system management bus (SMB) i.e. battery/power characteristics [Friel -- **Figure 3, Col. 6 lines 5-10 and 44-46, Col. 9 lines 45-52 and Col. 14 lines 42-50**].

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the battery pack module of Swartz-Wilz-Rosen to incorporate the data transfer of battery characteristics, i.e. amount of power left, voltage, etc., of Friel et al. in order to supply the user of the device with the useful and necessary power information so that they can monitor the battery status to prevent loss of information due to a dead battery.

Regarding claim 7, Swartz-Wilz-Rosen teach the invention substantially as claimed, as aforementioned in claim 1 above, including creating a data packet containing information extracted from the optical indicia [Swartz -- **Col. 9 lines 59-62 and Col. 11 lines 63-67 – Col. 12 lines 1-7 – Information, generated from optical indicia, i.e. bar code, is sent wirelessly over the network which requires it to be first put into a packet for transmission**] but fails to teach a memory and processor disposed within the housing for retrieving a first code.

Friel, however, teaches a battery pack comprising a memory disposed within the housing and having a first code stored therein, the first code being associated with a group attribute of the battery pack [Friel -- **Col. 14 lines 42-47 and Col. 9 lines 45-52 – First code group attribute**

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data, i.e. manufacturer data]; and a processor disposed within the housing and operably connected to the memory and to the data interface [**Friel -- Figure 3 and Col. 6 lines 5-10 and lines 44-46**]; wherein the processor can access the memory, retrieve the first code, and provide signals indicative of the first code at the data interface [**Friel -- Figure 3 and Col. 14 lines 42-50** – **In order for the data to be available to the host device through the data interface (System Management Bus – SMB), it is obvious the processor must access the data and send it across the SMB**].

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the battery pack of Swartz-Wilz-Rosen to include a processor and memory space which the processor can access as was shown in Friel et al., in order to be able to store battery operational characteristics and critical information that the host device may request and to further provide a means to send the requested data to the host to set up power schemes and to insure power failure and data loss due to a dead battery does not occur.

Regarding claim 8, Swartz-Wilz-Rosen-Friel teach the invention substantially as claimed, as aforementioned in claim 7 above, including a battery pack wherein the group attribute associated with the first code is an identification of the distributor of the battery pack [**Friel -- Col. 14 line 45**].

Regarding claim 9, Swartz-Wilz-Rosen-Friel teach the invention substantially as claimed, as aforementioned in claim 7 above, including a battery pack wherein the group attribute associated with the first code is an identification of the type of wireless communication device

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which the battery pack is configured to fit **[Friel -- Col. 14 line 45 – Manufacturer data encompasses a wide range of data including, but not limited to, serial number, device type, identification of the distributor, production date, etc...]**.

Regarding claim 10, Swartz-Wilz-Rosen-Friel teach the invention substantially as claimed, as aforementioned in claim 7 above, including a battery pack wherein the memory further includes a second code stored therein, the second code being associated with an individual attribute of the battery pack **[Friel -- Col. 9 lines 45-52 – Serial Number is unique attribute to each battery pack]**, and wherein the processor can access the memory, retrieve the second code, and provide signals indicative of the second code at the data interface **[Friel -- Figure 3 and Col. 14 lines 42-50 – In order for the data to be available to the host device through the data interface (System Management Bus – SMB), it is obvious the processor must access the data and send it across the SMB]**.

Regarding claim 11, Swartz-Wilz-Rosen-Friel teach the invention substantially as claimed, as aforementioned in claim 10 above, including a battery pack wherein the individual attribute associated with the second code is a serial number of the battery pack **[Friel -- Col. 9 line 51]**.

Regarding claim 12, Swartz-Wilz-Rosen-Friel teach the invention substantially as claimed, as aforementioned in claim 10 above, including a battery pack with on-board memory

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(RAM) which contains many variables and pack-specific values such as design capacity, design voltage, serial number, manufacture date, etc... **[Friel -- Col. 9 lines 50-52].**

It is well known in the art that many products request the user to enter his or her name to register or provide identification of the user of the product. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the identification of the user as one of the values within memory as to provide another means of uniquely identifying a product the owner of it.

Regarding claim 13, Swartz-Wilz-Rosen-Friel teach the invention substantially as claimed, as aforementioned in claim 1 above, including wherein the housing is adapted for attachment to a wireless communication device which is a cellular telephone **[Swartz -- Figure 10 and Col. 11 lines 63-64].**

Regarding claims 14 and 15, Swartz-Wilz-Rosen teach the invention substantially as claimed, as aforementioned in claim 1 above, but fail to teach wherein the wireless communication device is a handheld PC and a personal digital assistant (PDA). Friel, however, teaches wherein the housing is adapted for attachment to a wireless communication device which is a handheld PC **[Friel -- Col. 13 line 39 – A handheld PC is a type of portable computer]** and personal digital assistant (PDA) **[Friel -- Col. 13 line 39 – A PDA is one type of portable computer].**

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Swartz-Wilz-Rosen and Friel et al. in order to allow other

wireless communication devices to experience the usefulness and functionality that smart batteries provide to users.

Response to Arguments

6. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's arguments filed July 15, 2004 have been fully considered but they are not persuasive.

(A) Applicant contends that the amendments made to the claims have served to overcome the 35 U.S.C. 112 and 35 U.S.C. 103 rejection made against claim 1.

In response to argument (A), Examiner sets forth that the minor amendments made to the claims are not substantial enough to alter the meaning incurred from reading claim 1 (Amendment dated 12/16/2003) to the newly amended claim 1 (Amendment dated 7/14/2004). It would appear as though conflicting arguments are being presented that do not coincide with the invention as claimed. In the Remarks section of the Amendment dated 12/16/2003, Applicant states "the inventive concept...is

direct toward the concept of providing all the functionality necessary for the scanning and communication operation to effect a connection with a network, all of which is provided in the scan module.” See Page 10 of the Remarks section. If applicant wishes to follow this argument throughout the course of prosecution, 35 U.S.C. 112 rejection remains as no evidence has been shown either in the claims or the specification to support that the optical reader/battery pack can both scan and then effect a connection to be made to a network solely without the use of the wireless communication device.

However, in the Remarks section of the Amendment dated 7/14/2004, Applicant states that “data can be generated in the form of a routing packet that includes routing information and data, and this information routed to the phone and then through the GCN.” See Page 7 of the Remarks section. If applicant wishes to follow this argument throughout the course of prosecution, current rejection would stand as claim 1, even with the minor yet not meaning altering amendments made, would still be unpatentable over Swartz-Wilz-Friel as detailed in the rejection above. In addition, Applicant states (See Page 7 of the Remarks section) that the “battery pack provides power to the phone and provides the decoding and packet generation functionality.” Examiner invites applicant to point out where such functionality exists within the specification in which the battery pack can decode and generate packets. Furthermore, if found, language does not appear within the independent

claim, however, Examiner would encourage applicant to include such information in order to advance the prosecution of the case.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Mauro Jr. whose telephone number is 703-605-1234. The examiner can normally be reached on M-F 8:00a.m. - 4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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TMM
September 22, 2004



DAVID WILEY
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